Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AKIO OSHIRO, KOJI NIIMI, TOMOMI NAKAMURA, RYOUSUKE SAKAMAKI and MASANORI OISHI

Appeal No. 1999-1533
Application No. 08/666,948

HEARD: January 27, 2000

Before STAAB, NASE, and GONZALES, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2, 7, 10, 11, 14, 15, 18 and 19. Claims 3-6, 8, 9, 12, 13, 16, 17 and 20-25 have been withdrawn from consideration under 37 CFR § 1.142(b) as being drawn to a nonelected invention. No claim has been canceled.

We REVERSE.

BACKGROUND

The appellants' invention relates to an assembled part in an automated assembly line (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Lachaussee	4,170,284	Oct. 9, 1979
Mizuta et al. (Mizuta)	5,293,680	Mar. 15, 1994
Hollis et al. (Hollis)	5,579,885	Dec. 3, 1996
	(filed June 17, 1993)	

Claims 1, 2, 7, 10, 11, 14, 15, 18 and 19 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Lachaussee or Mizuta.

Claims 18 and 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Mizuta.

Claim 2 stands rejected under 35 U.S.C. § 103 as being unpatentable over Lachaussee or Mizuta in view of Hollis.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the final rejection (Paper No. 8, mailed August 18, 1998) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 12, filed January 19, 1999) and reply brief (Paper No. 15, filed May 3, 1999) for the appellants' arguments thereagainst.[1]

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the

[1] We note that the examiner's complete response to the argument of the appellants set forth in their brief was that "[n]o further comment is necessary" (Answer, Paper No. 13, mailed March 3, 1999).

examiner. As a consequence of our review, we make the determinations which follow.

The anticipation rejection

We will not sustain the rejection of claims 1, 2, 7, 10, 11, 14, 15, 18 and 19 under 35 U.S.C. § 102(b) as being anticipated by Lachaussee or Mizuta.

To support a rejection of a claim under 35 U.S.C. § 102(b), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Claim 1, the only independent claim on appeal, recites a combination of an assembled part and a conveyor. Claim 1 further recites that the conveyor includes, inter alia, a pair of opposed symmetrically located guides establishing a direction of conveyance, an upstream delivery member spaced apart from a downstream positioning member, and a mechanism

for moving the members in the direction of conveyance. Claim 1 also recites that the assembled part is "configured to be conveyed without rotation and guided through the movement of said delivery member and said positioning member as one body along said direction [of conveyance]." When read in light of the appellants' disclosure, we understand and interpret the above-quoted phrase to mean that the assembled part is moved in the direction of conveyance with substantially no angular translation, e.g., no twisting.

Lachaussee discloses a cartridge-making machine on which a transfer device according to his invention is provided. The work stations necessary for making the cartridges are distributed along a table 1 and cases 2 serving to make the cartridges are brought to the table 1 by a lever 17 mounted on the axle 8 (on the left looking at Figure 3) and are displaced to the right in succession. The cases are displaced on the table 1 by a transfer device, comprising a rake 3, a matrix bar 4, a retractable guide bar 5 and a straight edge 6. The rake 3 consists of a shaft equipped with teeth 41 engaging on bearings 14. The matrix bar 4 consists of a bar extending

parallel to the table 1 and having on its edge turned towards the rake 3 cut-outs 42, each having a profile capable of surrounding a part of the case 2. The retractable guide bar 5 is mounted on the end of a support 11 hinged on a pivot 12 fixed to the table 1, the bar 5 being maintained in the normal position by the action of a spring 13 and by the adjustable stop 25. The straight edge 6 is fixed on bearings 14 by means of adjusting screws 15. Holes 16 are provided in the straight edge 6 in order to adjust its
position in relation to the position of the cases 2.

Lachaussee teaches that the matrix bar 4 and the rake 3 are actuated by cam mechanisms mounted on a camshaft 10 running along the table 1. The mechanism controlling the matrix bar 4 can
be seen in Figure 1, while the mechanisms controlling the rake 3 are shown in Figures 4 and 5. The matrix bar 4 retains all the cases 2 in its cut-outs 42, the cases being backed up by the straight edge 6. The guide bar 5 runs opposite the bearing line of the rake 3 against the cases 2. Each case is thus held at at least four points, thereby ensuring accurate

centering thereof during the cartridge-making operations. While the operations on the cases 2 are being completed, the rake 3 is displaced by a longitudinal translatory movement backwards by one or more case positions (that is, towards the point of introduction of the cases) after which is it propelled in a rotary movement in order to bring the teeth 41 between the successive cases. As soon as the operations on the cases 2 are completed, the rake 3 is displaced by a translatory movement by one position forwards and when the cases occupy their new positions the rake 3 is propelled in a rotary movement disengaging the teeth 41 while the required operations are being carried out on the cases.

Mizuta discloses apparatus for processing molded synthetic resin materials (e.g., lower cassette halves 1a, 1b, 1c,). As shown in Figures 2 and 3, the apparatus is provided with position adjusting push members 3a and 3b, which adjusts the positions of the lower cassette halves 1a, 1b, and 1c at predetermined positions and perforating means 4 for making a group of recognition holes 2a, 2b, and 2c. The lower cassette halves 1a, 1b, and 1c are conveyed by feed claws 5a, 5b, and

5c of an intermittent feed means along a reference guide 8 and a side guide 9. The reference guide 8 and the side guide 9 extend on conveyance rails 6 and 7 in the direction, along which the lower
cassette halves 1a, 1b, and 1c are conveyed. When the lower cassette half 1a and the lower cassette half 1b reach the predetermined positions below the perforating means 4, a position adjusting block 10 is moved up by a driving means (not shown) and enters into the region between the lower cassette half 1a and the lower cassette half 1b. After the position adjusting block 10 has thus moved up, the position adjusting push members 3a and 3b are moved by a driving means (not shown) towards the lower cassette halves 1a and 1b. The position adjusting push
member 3a pushes a corner of the tail end of the lower cassette half 1a at the side of the reference guide 8 against a reference surface 11a of the position adjusting block 10 and the inner side surface of the reference guide 8 and thereby adjusts the position of the lower cassette half 1a. The position adjusting push member 3b pushes a corner of the leading end of the lower

cassette half 1b at the side of the reference guide 8 against a reference surface 11b of the position adjusting block 10 and the inner side surface of the reference guide 8 and thereby adjusts the position of the lower cassette half 1b.

Mizuta teaches that as shown in Figure 3, after the positions of the lower cassette halves 1a and 1b have been adjusted in the manner described above, the whole perforating means 4 moves down. After the perforating process has been finished, the perforating means 4 moves up and returns to its original position. At the same time, the position adjusting push members 3a and 3b move away from the lower cassette halves 1a and 1b, and the position adjusting block 10 moves down. In this manner, the lower cassette halves 1a and 1b are released from the position adjusting force. Thereafter, the lower cassette halves 1a and 1b are again conveyed by the intermittent feed means together with the other lower cassette halves to the downstream side.

The appellants argue (brief, pp. 3-6) that Lachaussee and Mizuta both fail to teach, either expressly or by the doctrine

of inherency, "a mechanism for moving said members in said direction with said assembled part being configured to be conveyed without rotation and guided through the movement of said delivery member and said positioning member as one body along said direction" as recited in claim 1. We agree.

The examiner's position (final rejection, p. 2) with respect to the above-noted limitation of claim 1 is that since both Lachaussee and Mizuta do not specifically disclose rotation of their articles relative to the article guides, the systems of Lachaussee and Mizuta "are designed to prevent article rotation."

It is well-settled that under principles of inherency, when a reference is silent about an asserted inherent characteristic, it must be clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). As the court stated in In re Oelrich, 666 F.2d 578, 581, 212 USPQ

323, 326 (CCPA 1981)(quoting Hansgirg v. Kemmer, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939)):

> Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. [Citations omitted.] If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

Here, the examiner's determination that the systems of Lachaussee and Mizuta "are designed to prevent article rotation" is simply speculative. It is our opinion that the examiner has not provided any evidence or scientific reasoning to establish the reasonableness of his belief that the above-noted limitation of claim 1 is an inherent characteristic of Lachaussee or Mizuta. In that regard, with respect to Lachaussee, we find that it more likely than not that cases 2 will rotate about their axis when pushed along the guide bar 5 and edge 6 by teeth 41 of the rake 3. With respect to Mizuta, we find that the amount of play inherent in Mizuta's apparatus is such that the above-noted limitation of claim 1 is not readable on Mizuta's apparatus.

For the reasons set forth above, Lachaussee and Mizuta do not meet the above-noted limitation of claim 1 and therefore do not anticipate claim 1. In light of the foregoing, the decision of the examiner to reject claim 1, as well as claims 2, 7, 10, 11, 14, 15, 18 and 19 dependent thereon, under 35 U.S.C. § 102(b) is reversed.

The obviousness rejections

We will not sustain the rejection of dependent claims 2, 18 and 19 under 35 U.S.C. § 103.

As set forth above, all the limitations of claim 1 are not present in either Lachaussee or Mizuta. We have reviewed the applied prior art (including the reference to Hollis applied in the rejection of claim 2) but find nothing therein which would have made it obvious at the time the invention was made to a person having ordinary skill in the art to have arrived at that claimed invention. Specifically, the applied prior art does not teach or suggest "a mechanism for moving said members in said direction with said assembled part being configured to be conveyed without rotation and guided through

the movement of said delivery member and said positioning member as one body along said direction" as recited in claim 1. Accordingly, the decision of the examiner to reject claims 2, 18 and 19 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 2, 7, 10, 11, 14, 15, 18 and 19 under 35 U.S.C. §

102(b) is reversed and the decision of the examiner to reject claims 2, 18 and 19 under 35 U.S.C. § 103 is reversed.

REVERSED

LAWRENCE J. STAAB Administrative Patent Judge	)	
JEFFREY V. NASE Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JOHN F. GONZALES Administrative Patent Judge	)	

OBLON SPIVAK MCCLELLAND MAIER & NUESTADT
FOURTH FLOOR
1755 JEFFERSON DAVIS HIGHWAY
ARLINGTON, VA 22202

APPEAL NO. 1999-1533 - JUDGE NASE
APPLICATION NO. 08/666,948

APJ NASE

APJ GONZALES

APJ STAAB

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: February 1, 2000

FINAL TYPED:

HEARD: January 27, 1999